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DATE: 09/13/2006 **PAGES (INCLUDING COVER PAGE):** 9

Notice of Appeal
TO: Examiner Gregory Webb, Art Unit 1751 **FAX:** 571.273.0053

FROM: Eileen T. Mathews **CLIENT MATTER:** 094342.0028

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COMMENTS:

Dear Examiner,

Please see the attached:

1. Notice of Appeal
2. Pre-Appeal Brief Request for Review
3. Petition for Extension of Time for two months.

My contact information is:

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Thank you.

Patent
Art Unit 1751
Docket US19984054-5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/699,262
Applicant(s)	:	Daniel C. Conrad et al.
Filed	:	October 31, 2003
T.C./A.U.	:	1751
Examiner	:	Gregory E. Webb
Docket No.	:	US19984054-5 (094342.0028)
For: Non-Aqueous Washing Machine and Methods		

I hereby certify that this correspondence is being faxed to the U. S. Patent and Trademark Office ATTN: Examiner Gregory E. Webb at 571.273.8300 on the date indicated below.

Name : Jennifer Safranek
Signature:
Date September 13, 2006

VIA FACSIMILE 571.273.0053
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P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the FINAL Office Action, mailed April 13, 2006, Applicants respectfully request a Pre-Appeal Review according to the procedures identified in the Patent and Trademark Office notice of July 12, 2005.

The prosecution dates relevant to discussion herewith are as follows:

a. First Office Action mailed on September 30, 2005
b. Response to First Office Action faxed on January 30, 2005
c. Final Office Action mailed on April 13, 2006
d. Response After Final faxed on July 13, 2006
e. Advisory Action mailed on August 18, 2006.

Applicants submit that the Final Office Action by the United States Patent and Trademark Office (USPTO) : 1) is unclear as to the nature of the rejections 2) is incomplete in regards to the disposition of amendments made prior to the Final Office Action in view of the cited references, and 3) lacks a prima facie case for rejection, for the reasons which are further described below.

I. Final Office Action Rejections under 35 U.S.C. §112, first paragraph

Lack of Clarity in Rejections

Applicants are unable to adequately respond in a complete manner in further prosecution of the subject patent application when the record is unclear as to the nature of the rejections.

1. Critical Element

In the Final Office Action claims 1-27 are rejected under 35 U.S.C. §112, first paragraph. The Final Office Action states:

> **"The phrase 'automatic consumer-operated laundering apparatus' is critical or essential to the practice of the invention, but not included in the claims(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976)." (No. 2)**

The *In re Mayhew* holding was based on the applicant's failure to include in the claim, a limitation which the specification indicated was an essential component of the invention. Therefore, it is unclear what is meant by this rejection since the Final Office Action states that a critical element is not included in the claims, whereas Applicants amended the claims to include a non-critical element "automatic consumer-operated laundering apparatus" in Response to the first Office Action. Applicants' discussion of this Final Office Action rejection can be found on pages 10-12 of the Response After Final filed on July 13, 2006.

2. New Matter

It is unclear as to whether the USPTO is asserting a new matter rejection under 35 U.S.C. §132 as the Final Office Action does not affirmatively make such a rejection. However, the Final Office Action implies that such a rejection has been made. It states:

> **"In an attempt to address these new matter limitations the following new rejections are added." (No. 4)**

Applicants are not clear as to whether the USPTO is simply addressing the claims in light of the amendment with new limitations, or if it is making a "new matter" rejection under 35 U.S.C. §132. Further discussion pertaining to this subject can be found on page 11 of the Response After Final filed on July 13, 2006.

Furthermore, Applicants believe that the amendments to recite "automatic consumer-operated laundering apparatus" in independent claims 1 and 19 and dependent claims 3, 4, and 5

does not constitute new matter as the terms "automatic", "machine", "apparatus", "laundering", "wash machine", and "consumer" are mentioned at several occurrences throughout the written description. For example, the term "automatic" is found in paragraphs 0005, 0006, 00028 and 0155; the term "consumer" is found in paragraphs 0007, 0028, 0029, 0030, 0034, 0035, 0038, 0048, 0067, and 0097; the term "apparatus" is found in paragraphs 0003, 0009, 116, 0120, 0122, and 0155; and the term "machine" is found in paragraphs 0005, 0006, 0010, 0027, 0028, 0030, 0046, 0048, 0067, 0071, 0083, 0085, 0116, 0143, 0144, 0145, 0152. In addition, the Abstract states, "The invention relates to a non-aqueous washing machine, methods of using the machine, methods of washing, and recycling."

There is ample support for Applicants' amendments pertaining to a method for cleaning in a automatic consumer-operated laundering apparatus which were made in Response to the First Office Action. If the rejection made in the Final Office Action is a new matter rejection under 35 U.S.C. §132, Applicants believe such a rejection is without merit.

3. Chemical Properties

It is unclear as to whether the USPTO is rejecting claims 1-27 as indefinite under §112 on the basis that claims are directed to a method comprising contacting fabric with chemicals (i.e. "working fluid") which are described by chemical and physical properties. While the Office Actions of record do not indicate that the terms of the claims are rejected as indefinite, the Examiner indicated in a telephonic interview of June 6, 2006, that the language pertaining to the working fluid - specifically the words "non-reactive", "non-aqueous", "non-oleophilic", and "apolar" - are indefinite because it is not clear what they encompass. Applicants wish to receive clarification as to whether all of the claims which recite properties of the working fluid are indefinite. It is well settled that acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, and that claim language need not be precise. (MPEP 2173.05(b)). See Section III. "Telephonic Interview" on pages 19-22 in the Response After Final. Applicants claim identifying properties that show its invention of methods for cleaning using a substantially inert working fluid of the described properties, distinguish it from the conventional methods which used working fluids specifically chosen to chemically clean fabric. Applicants' invention is a radical departure in thinking of pre-existing cleaning

methods which led to a counter-intuitive approach to cleaning fabric. See Section II A. "Novelty of Invention" on pages 12-13 of the Response After Final.

Applicants are further deprived if these issues of law are cause for rejection by the USPTO albeit not clearly presented in an office action, and thus delay issuance of a patent or remain after issuance as unresolved by USPTO. Other companies (some of which are suppliers to Assignee) have since experimented with, disclosed and claimed in patent applications species compositions of Applicants' class of compounds for the substantially inert working fluid.

II. Final Office Action Rejections under 35 U.S.C. §102(b)

Piecemeal Examination

Applicants respectfully submit that the Final Office Action does not address arguments made in response to the rejections under 35 U.S.C. §102 in view of the previously amended claims in response to the first Office Action dated September 30, 2005. MPEP 707.07(g) requires that the examination be accompanied by rejection on all other available grounds in order to advance prosecution and avoid piecemeal examination.

The Final Office Action states:

> **"As these terms are essential to the applicant's arguments, the applicant's arguments are considered moot and previous rejections are maintained." (No. 3)**

However, in view of the rejections of claims 1-27 under §112, for either lack of a critical element or new matter, or both in the Final Office Action, the MPEP requires that the USPTO address the arguments made by the Applicants in response to the rejections of the claims under §102(b) in view of the amended claims to the extent they can be interpreted. Applicants are, therefore, deprived of a complete examination and the benefit of the fee paid to the USPTO and the issuance of a patent is further delayed. Discussion of MPEP 707.07(g) and a request that the finality of the Office Action be withdrawn in order to remove an issue for appeal, is found on page 12 of the Response After Final.

Claims 1-27 are not Anticipated

The United States Patent and Trademark Office (USPTO) has failed to establish a prima facie rejection of claims 1-27 under §102(b) because of the omission of one or more essential

elements. In regards to independent claims 1 and 19, at least one of the following elements is missing from each of the cited references: 1) bringing together an inert working fluid of the defined properties in contact with an adjuvant, and 2) applying mechanical energy to the fabric in an automatic laundering apparatus. The cited references fail to disclose or infer a method of bringing together a substantially non-reactive, non-aqueous, non-oleophilic, apolar working fluid in contact with an adjuvant, and applying mechanical energy to the fabric in an automatic laundering apparatus.

Novel Elements in Dependant Claims not Addressed

Furthermore, the office actions do not address claimed elements recited in several dependent claims. For example, dependent claims 2 and 20 further recites a method of cleaning with a working fluid having strictly measurable physical properties (specifically surface tension, solubility, and KB value), which are not disclosed nor implied by any of the references.

Additional dependent claims recite at least one element which are not disclosed by the references, and the cited references do not teach a unitary, integral method which embodies expressly or inherently all of the features of the inventive method as claimed and as required under 35 U.S.C. §102(b).

Conclusion

Applicants respectfully request a clarification of the rejections applicable to the claims in the present application, a complete review of the arguments made by applicant in response to these rejections, withdrawal of these rejections in view of these arguments, and an allowance of these claims. If during the Pre-Appeal review, the panel would like further clarification, the panel is invited to contact the undersigned. If there are any fees necessitated by the foregoing communication, please charge such fees to our Deposit Account No. 50-0959, referencing our Docket No. US19984054-5 (094342.0028).

Respectfully submitted,
ROETZEL & ANDRESS

September 13, 2006
Date

Eileen T. Mathews, Reg. No. 41,973

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